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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,001	03/31/2004	Ganesh Kannan	130488-1	1399

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EXAMINER
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BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/815,001

Applicant(s)

KANNAN ET AL.

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/31/04;10/14/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

Applicant's request to cancel claims 1-8 cannot be entered. Any such amendment must be made in accordance with 37 CFR 1.121 (ie a complete listing of all claims with appropriate status identifiers).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-13,20,21,30,32-34 and 42-45 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"particularly" in claims 11,20 and 44 is unclear. Are these requirements or not?

The esters, salts etc of claims 12,13,21,,33,34 and 45 are not diacids.

There is no antecedent basis for "D" in claim 30.

There is no antecedent basis for the stabilizing additive in claims 42 and 43.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-12 and 14-27 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP54125271.

The reference produces a polyesteramide from diols, diacids and an esteramide compound (I). The esteramide (I) appears to correspond to applicant's esteramide compound.

Claims 9,12,14-17,19 and 21-27 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kirikihira '495.

Kirikihira produces applicant's esteramide compound (col 3 line 46). Kirikihira then polymerizes this esteramide with glycol and dicarboxylate diester (col 5 line 40-41). Polymerization can be conducted in a solvent (col 6 line 8), with a catalyst (col 4 line 15) at 150-300C (col 4 line 7).

Claims 9-18 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kibler '826.

Kibler claims (#5) polyesteramides made from hexahydroterephthalic acid, cyclohexanedimethanol and aminocaproic acid. Although Kibler does not add esteramide as a starting monomer, the units of the resulting polymer are believed to correspond the units of applicant's polymer. This is because the esteramide of applicant's claims is merely a prereaction of the caproic acid and diacid. The final product would be the same whether or not such a prereaction was carried out. Note that R2 of applicant's esteramide does not form a part of the final polymer, but is instead cleaved away during transesterification.

Claims 9-12,14-22,24,25,28-33 and 35-45 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bailly EP730005.

Bailly (abstract) discloses blends of polycarbonate with polyesteramide. The polyesteramide can be made reacting diamine with a diester of terephthalic acid to form a bisester diamide (page 7 line 39-41) prior to polymerization with diol and additional terephthalic acid (page 7 line 47). This compound (pictured at page 5 formula IX) corresponds to applicant's esteramide when Bailly's "Z" is -OR. Note that applicant permits his R1 to be substituted which allows his R1 to be the -R6NHC(O)R8- of Bailly's formula. Alternatively, Bailly can use an amino acid such as aminobutyric acid (page 4 line 21) in place of the diamine. An amino acid prereacted with terephthalic acid would correspond to applicant's preferred esteramide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER  
PRIMARY EXAMINER

David Buttner

8/11/06

A handwritten signature in black ink, appearing to read "David Buttner", written in a cursive style.